

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 101 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 101

Claims 2-5, 8-15 and 17-28 are rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 9, 10, 12 and 26 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Next, independent system claims 2 and 8 have been amended to recite a system including one or more

computers on a network for automatically targeting Web-based advertisements. These amendments are supported, for example, by Figure 1 and page 4, lines 21-28 and page 6, line 26 through page 7, line 3 of the specification.

Finally, independent method claim 15 has been amended to recite that each of the acts of the computer-implemented method is performed by a computer system including at least one computer on a network. This amendment is supported, for example, by Figure 1 and page 4, lines 21-28 and page 6, line 26 through page 7, line 3 of the specification.

Thus, in view of the foregoing amendments and remarks, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2-5, 8, 11, 13-15, 17-25, 27 and 28.

Rejections under 35 U.S.C. § 103

Claims 2-5, 8, 12-15, 17-19, 21, 22, 26-28 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application No. 2002-073680 ("the Mitsubishi publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, independent claim 2 has been amended to include the features of claim 12 (now canceled). Specifically, claim 2 has been amended to further recite ***an advertising creative generator to generate an advertising creative based on the characteristics of at least one such identified advertisement to include in the***

corresponding advertisement. Independent claims 15 and 30 have been similarly amended.

Independent claim 2, as amended, is not rendered obvious by the Mitsubishi publication because the Mitsubishi publication neither teaches, nor makes obvious, an **advertising creative generator to generate an advertising creative based on the characteristics of at least one such identified advertisement to include in the corresponding advertisement.** In rejecting original claim 12 (now canceled) which recited this feature, the Examiner cites paragraph [0092] of the Mitsubishi publication as teaching this feature. The applicants respectfully disagree.

In exemplary embodiments consistent with the claimed invention, each advertisement 45 is structured to store advertising information and characteristics as shown, for example, in Figure 3. (See Page 7, lines 21-23 of the specification.) The advertising excerpts can also include Web content, news messages, advertisements, and other content, including the Web content, news messages, advertisements, as well as documents and excerpts from other sources. (See Page 7, lines 23-27 of the specification.) The "**advertising creative generation component builds Web-based advertising creatives for inclusion in the advertisement sets 42 or advertisements 45**" using, for example, the aforementioned advertising excerpts. (Page 11, lines 3-5 of the specification) The specification further provides:

the advertising creative generation component 50 uses the terms 40 that constitute each query 39 to help identify and summarize the product or

service information contained within advertising excerpts 46 into advertising creatives, such as further described below with reference to FIGURES 5A-C. In a further embodiment of the invention, the optional advertising creative generation component 50 generates advertising creatives based on the category names 51 and can use any other type or source of information describing the products or services. The generated advertising creative is then provided to the advertising server 22 for inclusion with or in lieu of the Web content 24, news messages 25, and other content 27.

In a further embodiment of the invention, advertising creatives can be specified relative to an advertisement 45, either directly by including an advertising creative with the advertisement 45, or indirectly, such as through a hyperlink associated with the advertisement 45. Alternatively, the corresponding advertising excerpt 43 can include hints or predefined text, which could be used as an advertising creative. As well, advertising creatives can be precomputed or cached.

(Page 11, lines 5-21 of the specification)

By contrast, paragraph [0092] of the machine translation of the Mitsubishi publication provides:

Drawing 20 is a figure showing the example of a screen display of the search results displayed on the terminal unit 1 for users. Like a graphic display, the viewing area of advertisement information is provided in addition to the viewing area of a retrieval sentence, the viewing area of the extraction result list of technical

information, and the viewing area of the detailed content of the technical information. The size of this viewing area may be arbitrarily changed according to the number of advertisement information.

As best as could be understood from the machine translation of the Mitsubishi publication, this section merely concerns the display of the search results (i.e., "extraction result list of technical information") and associated advertisements. It does not teach, nor does it make obvious, an **advertising creative generator to generate an advertising creative based on the characteristics of at least one such identified advertisement to include in the corresponding advertisement.**

Thus, claim 2, as amended, is not rendered obvious by the Mitsubishi publication for at least the foregoing reason. Claims 15 and 30 have been similarly amended and, therefore, are similarly not rendered obvious by the Mitsubishi publication. Since claims 3-5, 13 and 14 directly or indirectly depend from claim 2, and since claims 17-19, 21, 22, 27 and 28 directly or indirectly depend from claim 15, these claims are similarly not rendered obvious by the Mitsubishi publication.

Next, independent claim 8, as amended, is not rendered obvious by the Mitsubishi publication, since the Mitsubishi publication neither teaches, nor makes obvious, a selector to select at least some of the ordered identified advertisements relative to a ranking cutoff, **wherein the ranking cutoff is based on at least being a product of a fixed cost and a variable cost.**

In exemplary embodiments consistent with the claimed invention, a ranking cutoff may advantageously be used to further reduce the amount of advertisements considered based on the **product of a fixed cost (48) and a variable cost (49)**. (See Page 10, line 26 through page 11, line 2 and page 18 lines 10-12 of the specification.) Specifically, the specification describes selection of the advertisements using the following iterative process as shown in Figure 8:

Following pruning, each remaining advertising result 43 is iteratively processed (blocks 124-129), as follows. **The fixed cost 48 associated with the advertising result 43 is obtained (block 126)**, based on, for example, the size, layout and content of the advertisement 45. Similarly, the **variable cost 49 associated with the advertising result 43 is determined (block 126)**, based on, for example, display, selection frequency or similar factors. Optionally, if either the fixed cost 48 or variable cost 49 is too low (block 127), the advertising result 43 is eliminated from further consideration (block 128). The variable cost 49 and fixed cost 48 can be considered separately or in combination. In a further embodiment of the invention, a threshold can be adjusted following an evaluation of one or both of the fixed cost 48 and variable cost 49 and the advertising result 43 can be eliminated from further consideration if the threshold is not met. Each remaining advertising result 43 is processed (block 129).

Next, those advertising results 43 with sufficient relevancy and associated fixed and variable costs are ranked (block 130) by applying a selection criteria. In the described

embodiment, a ranking cutoff is applied to the product of the fixed costs 48 and variable costs 49 with a randomization element to determine the advertising results 43, which are acceptable. The ranked advertising results 43 can then be ordered and evaluated against the ranking cutoff to filter the advertising results 43. Following ranking, the top n remaining advertising results 43 are selected (block 131) for generation as advertising creatives, where n is greater than one. The routine then returns. [Emphasis added.]

(Page 17, line 26 through page 18, line 17 of the specification.)

The Mitsubishi publication does not teach, nor does it make obvious, teach a selector to select at least some of the ordered identified advertisements relative to a ranking cutoff, *wherein the ranking cutoff is based on at least a product of a fixed cost and a variable cost* as recited.

Thus, claim 8, as amended, is not rendered obvious by the Mitsubishi publication for at least the foregoing reason.

Claims 9-11 and 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Mitsubishi publication in view of U.S. Patent Application Publication No. 2003/0050863 ("the Radwin publication") and U.S. Patent No. 6,216,129 ("the Elderling patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 9 and 10 have been canceled,

this ground of rejection is rendered moot with respect to these claims.

Next, claim 11 depends from claim 8 and claims 23-25 indirectly depend from claim 15. The purported teachings of the Radwin publication and the Elderling patent would not compensate for the deficiencies of the Mitsubishi publication with respect to claims 8 and 15, as amended (discussed above), regardless of the scope of the purported teachings of the Radwin publication and the Elderling patent, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 11 and 23-25 are not rendered obvious by the cited references for at least this reason.

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Mitsubishi publication in view of the Radwin publication. (Although the Examiner listed claim 15 as being rejected on page 10 of Paper No. 20091105, the applicants believe the Examiner intended claim 20.) The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claim 20 depends from claim 15. The purported teachings of the Radwin publication would not compensate for the deficiencies of the Mitsubishi publication with respect to claim 15, as amended (discussed above), regardless of the scope of the purported teachings of the Radwin publication, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claim 20 is not rendered obvious by the cited references for at least this reason.

Claim Amendments

In addition to the amendments discussed above, independent claim 30 has been amended to remove means-plus-function elements and to include at least one processor and at least one storage device storing a computer executable code which, when executed by the at least one processor, performs a method. These amendments are supported, for example, by Figure 1 and page 4, lines 21-28 and page 6, line 26 through page 7, line 3 of the specification.

New Claims

New claims 31 and 32 depend from claims 2 and 15, respectively, and are supported by page 11, lines 5-9 of the specification.

New claims 33 and 34 depend from claims 2 and 15, respectively, and are supported by page 12, line 30 through page 13, line 26.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,



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